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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,261	07/13/2001	John MacAlister	1965-1-3	4870
996	7590	05/18/2004	EXAMINER	
GRAYBEAL, JACKSON, HALEY LLP 155 - 108TH AVENUE NE SUITE 350 BELLEVUE, WA 98004-5901			AHMAD, NASSER	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/905,261	Applicant(s) MACALISTER ET AL.	
	Examiner Nasser Ahmad	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 20-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 24-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Rejections Withdrawn

1. Claims 24-29, 33 and 36-40 rejected under 35 USC 103(a) as being unpatentable over Kassab has been withdrawn in view of amendment filed on February 26, 2004.
2. Claims 24-40 rejected under 35 USC 103(a) as being unpatentable over Kassab has been withdrawn in view of the amendment filed.
3. Claims 1-2, 4-11, 13, 16-19, 24-30 and 33-41 rejected under 35 USC 102(b) as being anticipated by Shanley in view of the amendment filed.
4. Claims 1-19 and 24-41 rejected under 25 USC 103(a) as being unpatentable over Shanley in view of Longtin in view of applicant's amendment filed on February 26, 2004.

Response to Arguments

5. Applicant's arguments with respect to claims 1-19 and 24-41 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 24-29 and 33-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Su (5,462,782).

Su relates to a mount (4) for mounting paper to glass (col. 1, lines 10-12). The mount comprises a body (2) of single material and having a first surface carrying an adhesive coating (3) capable of adhering the mount to only to a part of one surface of a sheet of paper to form a mountable arrangement and a second surface capable of securing such a mountable arrangement directly to glass without adhesive (col. 2, lines 13-25), wherein the first and second surface are mutually opposite. The first and second surface of the mount is flat, flexible and comprises plastic material such as polyvinyl chloride (figure-1 and col. 1, lines 62-67). The second surface is not capable of adhering to paper because it adheres to a glazy or smooth surface and paper does not have a glazy or smooth surface. The adhesive surface is releasably adhered to a release (1) or backing material (fig-1). The entire surface of the mount is adhered to less than half the surface area of the sheet. Further, Su teaches a method for securing a first material to a second material using the mount assembly.

Also, the phrase "capable of" does not constitute a limitation in any patentable sense and has not been given patentable weight because said phrase is not deemed to be of

Art Unit: 1772

positive limitation as it is directed to only its ability to so perform. *In re Hutchison*, 69 USPQ 138.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-10, 13-17, 19, 24-29 and 31-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Su.

Su, as discussed above, fails to teach the assembly comprises a plurality of mounts adhered to a single backing sheet. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a plurality of mounts of Su on a single backing sheet to facilitate production of the product in duplicates, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Further, the presence of sheet in a roll form, instead of sheet form, would have been obvious to one having ordinary skill in the art to provide for facilitating storage and shipping of the product and are found to be functionally equivalent.

As for the thickness being upto 2mm and the surface area being 100 to 900sqmm, it would have been obvious to one having ordinary skill in the art to provide said thickness for structure and strength, with the surface area for adhering ability, based on optimization through routine experimentation.

10. Claims 11-12, 18 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Su in view of GB: 1,005,155.

Su, as discussed above, fails to teach the presence of plasticizer in the mount of polyvinyl chloride. GB: 1,005,155 relates to a polyvinyl chloride resin film strips and the resin commonly comprises 50 to 100 parts of plasticizer per 100 parts of the polyvinyl chloride (page-1, lines 17-23) such that the resin does not become stiff. Therefore, it would have been obvious to one having ordinary skill in the art to utilize GB: 1,005,155's teaching of providing commonly used plasticizers in the polyvinyl chloride resin strips in the invention of Su with the motivation to prevent the strips from stiffening.

Further, it is well known for the resin to contain additives such as fillers that would impart some color to the film strips, in the alternative, the presence of pigments/color in the resin strips would have been obvious design choice modification to provide aesthetic appeal to the product.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

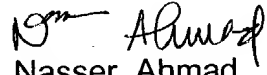
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 1772

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the

Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad
Primary Examiner
Art Unit 1772

N. Ahmad.
May 16, 2004.